

U.S.S.N. 09/474,536

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24707A

REMARKS

Claims 1-9, 11, 15-18 and 20-24 are currently pending in the application.

Claims 22 and 24 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing matter "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (Office Action, p. 3, ¶2). Specifically, the contention is made that the limitation requiring that the primary fibers are "other than polypropylene" is new matter "because this negative limitation is not literally supported by the specification." (*Id.*).

Claims 1-9, 15-18, 21 and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,773,375 to Swan et al. "further evidenced by Carey et al. and EP 0538047 A1." Claims 11 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Swan et al. in further view of Weirle et al. (U.S. Patent No. 4,840,832).

Rejection of claims 22 and 24 under 35 U.S.C. §112, first paragraph

Applicant respectfully traverses the rejections of claims 22 and 24 under Section 112, first paragraph.

To properly reject a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, the Examiner must establish that the originally-filed disclosure would not have reasonably conveyed to a skilled artisan that the Applicant possessed the now claimed subject matter.¹ Adequate description under this section does not, however, require literal support for the claimed invention.² Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that the inventor(s) had possession of the concept of what is claimed.³

¹ Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

² In re Herschler, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); In re Edwards, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

³ In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

On page 3 of the final Office Action at paragraph 1(b), the contention is made that the limitation "'in which the primary fibers are polymer fibers other than polypropylene' is not supported by the Specification." (Emphasis added). Furthermore, in paragraph 3 on that same page, the Examiner contends that this phrase is new matter "because this negative limitation is not literally supported by the specification." (Emphasis added). Support for this proposition is allegedly provided by the Board's decision in Ex parte Grasselli, 231 USPQ 393.

Applicant respectfully submits that these Section 112 rejections cannot stand for several reasons. First of all, a lack of literal support cannot establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112. This is made clear by a myriad of Board decisions, and the Examiner cites no authority to the contrary.⁴

Secondly, the statement made in support of the rejection is simply not accurate. On page 7, at line 16, the present specification clearly describes several different types of primary fibers "other than polypropylene," including polyethylene and polyethylene terephthalate. Consequently, the specification does indeed provide "literal support" for primary fibers made of materials "other than polypropylene."

Finally, the Board's decision in Ex Parte Grasselli (which is more than twenty years old and has never been followed in any published Board decision) is plainly distinguishable on the present facts. It involved a situation where a negative limitation "did not appear in the specification as filed" and "introduce[d] new concepts." (Emphasis added). In stark contrast, the "negative" limitation here does indeed have explicit, literal support in the specification as filed, since primary fibers "other than polypropylene" are expressly disclosed. Thus, the limitation here cannot be considered to "introduce new concepts" like the one under consideration in Ex Parte Grasselli. For the foregoing reasons, reconsideration of the rejection of claims 22 and 24 is respectfully requested.

⁴ In re Herschler, supra; In re Edwards, supra; In re Wertheim, supra.

Rejection of claims 1-9, 15-18, 21 and 23 under 35 U.S.C. §102(b)

Claims 1-9, 15-18, 21 and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,773,375 to Swan et al. "further evidenced by Carey et al. and EP 0538047 A1." Reconsideration of these rejections is respectfully requested.

Pending claim 1 reads on an acoustical insulation product for a vehicle comprising a blanket of fibers and a facing material adhered to a major surface of the blanket. The product includes a densified perimeter flange providing stiffness and capable of being held in place on the vehicle by an attachment system. The blanket of polymer fibers includes primary fibers and bi-component polymer binder fibers made of a principal polymer component and a binder polymer component having a softening point lower than the softening point of the principal component. *Having been heated to a temperature insufficient to soften the principal component but sufficient to soften the binder component*, the bi-component polymer binder fibers and the primary fibers are bonded to themselves and to each other. Independent claim 15 also includes the highlighted limitation.

The Examiner implicitly admits that the Swan et al. patent is silent as to an end product having been heated to bond any bi-component polymer binder fibers and primary fibers to themselves and to each other without softening the principal component of the binder fibers. Nevertheless, the contention is made in the final Office Action that "[a] heating step that will activate this type of fibers is well known in the art in order to produce the bonding by activating the adhesive polymer in the sheath of the bicomponent fiber while the core is the supporting component and has a higher softening component." (Office Action p. 2 ¶1). Moreover, the Examiner takes the position that Swan et al. "does provide the structure claimed . . . [since] the application of a heating step is implied with the use of this type of fibers." (*Id.*; emphasis added).

Applicant respectfully submits that the Examiner does not make the *prima facie* showing necessary to support an anticipation rejection under Section 102(b). First of all, the Examiner leaves unchallenged Applicant's contention that Swan et al. does not

expressly disclose the claimed end product having been heated to bond any bi-component polymer binder fibers and primary fibers to themselves and to each other without softening the principal component of the binder fibers. Accordingly, an "express" anticipation situation is not present.

The only other way to establish anticipation is by demonstrating that Swan et al. "inherently" discloses the claimed feature. To do so, extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."⁵ However, "[i]nherency . . . may not be established by probabilities or possibilities," and "[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient."⁶

As noted above, the Examiner supports the anticipation rejections by asserting that the application of a "heating" step is implied in Swan et al. Even if true, claims 1 and 15 require not just "heating" of the fibers, but heating sufficient to bond any bi-component polymer binder fibers and primary fibers to themselves and to each other without softening the principal component of the binder fibers. The mere "possibility" that this may result from the arrangement disclosed in Swan et al. under a given set of circumstances simply cannot support a rejection based on anticipation by inherency.

Citation is also made to Carey, Jr. et al. (U.S. Patent No. 4,837,067) and EP 0538047A1 "to further support the position" that a "heating step" is implied in Swan et al. As emphasized in the prior response made, Carey, Jr. et al. is silent as to whether the heating is sufficient to bond any bi-component polymer binder fibers and primary fibers to themselves and to each other without softening the principal component of the binder fibers, and the Examiner does not assert otherwise. Even if newly cited EP 0538047A1 teaches "a nonwoven material containing bi-component synthetic fibers having a thermoplastic component with a lower softening point component, such as a sheath-core

⁵ Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2D 1746, 1749 (Fed. Cir. 1991).

⁶ Id. at 1269, 20 U.S.P.Q.2D at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)).

bicomponent fiber and . . . exposing the fibers to a bonding temperature sufficiently high to soften the lower softening point component of the bicomponent fibers," as contended, this does not *per se* establish that such is inherent in Swan et al. Again, the "mere possibility" that what is claimed may result from a heating step is insufficient to establish anticipation based on Swan et al., and nothing in the secondary references establishes that the claimed matter "necessarily" results from the approach followed in Swan et al.

Claims 21 and 23 are rejected as anticipated over these same references, but without substantive analysis. Both of these claims expressly require that the primary fibers are "substantially free of melt-blown fibers." Since the Examiner admits that the primary fibers in Swan et al. are in fact melt-blown fibers (Office Action, p. 4 ¶1), it cannot possibly anticipate these claims, as is contended.

In light of the foregoing, claims 1, 15, 21 and 23 patentably distinguish over the cited patents and should be allowed. It likewise follows that the dependent claims are in condition for allowance as well. Reconsideration is, therefore, respectfully requested.

Rejection of claims 11 and 20 under 35 U.S.C. §103(a)

Claims 11 and 20 stand rejected as being unpatentable over Swan et al., as applied to claims 1-9, 15-18, and 21-23 above, and further in view of Weinle et al. (U.S. Patent No. 4,840,832). Applicant respectfully requests reconsideration of these rejections.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."⁷ One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.⁸

Claim 11 explicitly provides that the primary fibers of the blanket are polyethylene terephthalate fibers and that the bi-component binder fibers include a core of polyethylene terephthalate and a sheath of polyethylene terephthalate. The Examiner concedes that the Swan et al. patent does not supply this teaching (Office Action p. 7 ¶ 6), but nevertheless cites to the secondary Weinle et al. patent as providing it, since it allegedly "teaches the use of bi-component fibers . . . wherein the core is formed of a relatively high melting polyethylene terephthalate polymer (PET) and the sheath comprises a PET co-polymer having a much lower melting temperature." The alleged motivation for the combination is to "provid[e] an insulation material with a molded batt of fibers that remains highly deformable and resilient as disclosed by WEINLE et al. (Column 3, lines 56-68)."

The stated goal of "providing an insulation material with a molded batt of fibers that remains highly deformable and resilient" is insufficient to explain why a skilled artisan would have selected the bi-component fibers of the Weinle et al. for use in the arrangement disclosed in Swan et al. Indeed, nothing in the record establishes that the alleged combination would even meet this goal, including when the fibers are heated as required in the corresponding independent claim (on which point both patents are admittedly silent). In the absence of evidence showing why a skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed, a *prima facie* case of obviousness is lacking with respect to these dependent claims.

⁷ In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

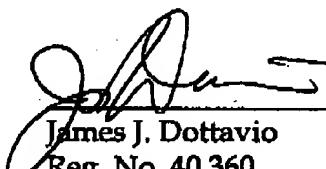
⁸ In re Fine, 837 F.2d at 1075.

Hence, claims 11 and 20 are not obvious in view of the cited prior art. Reconsideration of the rejections of these claims is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant submits that claims 1-9, 11, 15-18 and 20-24 are in proper form and allowable over the cited prior art and respectfully requests reconsideration of all rejections made. The Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167 to discuss any remaining issues, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,



James J. Dottavio
Reg. No. 40,360

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Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-7167